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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,368	02/10/2004	Edward J. Stashuk JR.	067439.0161	9915
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 08/19/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/775,368

Applicant(s)

STASHLUK ET AL.

Examiner

THUY-VI NGUYEN

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 06/22/09.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/22/09 has been entered.

2. This is in response to the applicant's communication filed on 06/22/09 wherein:
- Claims 1-32 are currently pending;
- Claims 1, 14-32 have been amended;

Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-13** (Method) are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*,

409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 1-13, the method claims are:

- (1) not tied to a particular machine or apparatus, nor
- (2) transforms a particular article to a different state or thing.

With respect to **1-13**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. For instance in claim 1, the process steps of "*accessing...; correlating...; generating...; formatting...*" is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Here claims fail to meet the above requirements since there is not a sufficient tie to another statutory class (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as "computer-implemented" or "using a computer" features in the critical functions/bodies of the claims would overcome the rejections.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over TIBBS ET AL (US 2002/0010689) in view of SAVINO ET AL (US 6,015,167)

As for claim 1, TIBBS ET AL discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a transaction, comprising the steps of:

a) accessing item data representing at least one detail about the item
{see figures 3, 4A-4F, pars. 0008, 0029-0031 discloses customer or user is accessing item data from the web merchant, e.g. "*users selects the item to be returned from product table*";

b) accessing transaction data representing at least one detail about the transaction associated with the item;

{see figures 3, 4A-4F, pars. 0008, 0029-0032 discloses items data with "*quantity of the item*" that customer wishes return};

c) accessing customer data representing at least one detail about a customer associated with the transaction

{{see figures 3, 4A-4F, pars. 0008, 0029, 0032 discloses customer information e.g. "*obtain customer address*";

d) accessing package data representing at least one detail about the package in which the item is expected to be shipped

{see figures 3, 4A-4F, 5, pars. 0008, 0029, 0032 discloses package data such as information related to *the size and weight of the package to be shipped*};

e) correlating the item data, transaction data, customer data, and package data with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages to be shipped from the customer to a returns center and represent guidelines/information such as choice of carrier, shipping destination, shipping rate

{see figures 4A-4F, 5 and 6, at least pars. 0032-0034 shows customer submits a returned request, then the system is generating the return shipping label based on the customer submitted data e.g. customer address, items number and the quantity to be returned, and weight and dimension of the package. The return shipping label is transmitted to the customer including information about the shipping instructions or

guidelines (Figures 6-8). As for the "business rules" feature, It is inherent that when a return request is made by a customer, business rules would be applied in order to determine what shipping information should be provided to the customer.

g) formatting the return shipping label and complies with shipping labels specification of the choice of carrier

{see figures 3 (steps 365, 370), figures 5-8; discloses the generating the shipping labels complying with shipping label information such as carrier label barcode}.

Note: for convenience, letters (a)-(g) are added to the beginning of each step.

TIBBS ET AL discloses the claimed invention as stated above. **TIBBS ET AL** further discloses generating the shipping label with the bar code/machine readable code represents the carrier or the post office as shown on pars. 0034, figures 5-6. However **TIBBS ET AL** does not explicitly discloses the machine readable code for the shipping label represents the shipping information such as item data, customer data, transaction data, package data (step f).

In the similar method for generating and transmitting electronic shipping label including a barcode, **SAVINO ET AL** discloses a method of employing a single bar code shipping label for coordinating shipping and receiving information between supplier and customers in order to reduce the time consuming and costly. A bar code value represents plurality of predetermined relevant purchase and shipping information associated with a purchase order such as customer name and address, packing slip number, customer purchase order number, part/item quantity number, customer part number, shipping information so that the user need only scan a single bar code to

retrieve from the database all relevant purchase and shipping information {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-47, col. 24-35}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of **TIBBS ET AL** to include the shipping label contains the machine readable code which represents a purchase order and shipping information as taught by **SAVINO ET AL** for the advantage of more efficient and time effective than conventional systems which employ a plurality of codes which must all be individually scanned for a single part or purchase order. {see **SAVINO ET AL**, col. 4, lines 44-67; col. 5, lines 1-21}.

As for dep. claims 2-10 which discloses the information/data about the items and the transaction, customer information, package information, this is fairly taught in **TIBBS ET AL**, see figures 44A-4F, 5-6, pars. 0029-0032}.

As for claims 11-13, which discloses accessing the information such as shipping information, carrier center location information, mail information, this is fairly taught in **TIBBS ET AL**, see figures 5-8, pars. 0035, 0041-0042}.

Note: As for the "data or information" recites in dep. 2-13, this information have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for independent claim 14, which discloses a software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim as stated above.

As for dep. claim 15, which discloses the accessing the group of information/data such as item data, customer data, transaction data via a remote data communication link, this is taught in TIBBS ET AL, see figures 1-2, 4A-4F}.

As for dep. claims 16-18, which discloses the access shipping information include the shipping rate, and carrier location data and mail data , this is taught in TIBBS ET AL, see figures 5-8}.

As for dep. claims 19-27, basically these claims carry the similar steps as for the dep. claims 2-10 above. They are rejected for the same reason sets forth the dep. Claims 2-10 as stated above.

As for claim 28, TIBBS ET AL discloses a computer product for providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising programming operable to:

- a) accessing item data representing at least one detail about the item

{see figures 3, 4A-4F, pars. 0008, 0029-0031 discloses customer or user is accessing item data from the web merchant, e.g. *"users selects the item to be returned from product table"*};

b) accessing transaction data representing at least one detail about the transaction associated with the item;

{see figures 3, 4A-4F, pars. 0008, 0029-0032 discloses items data with *"quantity of the item"* that customer wishes return};

c) correlating the item data, transaction data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages to be shipped from the customer to a returns center and represent guidelines/information such as choice of carrier, shipping destination, shipping rate

{see figures 4A-4F, 5 and 6, at least pars. 0032-0034 shows customer submits a returned request, then the system is generating the return shipping label based on the customer submitted data e.g. customer address, items number and the quantity to be returned, and weight and dimension of the package. The return shipping label is transmitted to the customer including information about the shipping instructions or guidelines (Figures 6-8). As for the "business rules" feature, It is inherent that when a return request is made by a customer, business rules would be applied in order to determine what shipping information should be provided to the customer.

e) formatting the return shipping label and complies with shipping labels specification of the choice of carrier

{see figures 3 (steps 365, 370), figures 5-8; discloses the generating the shipping labels complying with shipping label information such as carrier label barcode}.

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

TIBBS ET AL discloses the claimed invention as stated above. **TIBBS ET AL** further discloses generating the shipping label with the bar code/machine readable code represents the carrier or the post office as shown on pars. 0034, figures 5-6. However **TIBBS ET AL** does not explicitly discloses the machine readable code for the shipping label represents the shipping information such as item data, customer data, transaction data, package data (step d).

In the similar method for generating and transmitting electronic shipping label including a barcode, **SAVINO ET AL** discloses a method of employing a single bar code shipping label for coordinating shipping and receiving information between supplier and customers in order to reduce the time consuming and costly. A bar code value represents plurality of predetermined relevant purchase and shipping information associated with a purchase order such as customer name and address, packing slip number, customer purchase order number, part/item quantity number, customer part number, shipping information so that the user need only scan a single bar code to retrieve from the database all relevant purchase and shipping information {see figures 4-5, at least col. 2, lines 7-19; col. 3, lines 34-47, col. 24-35}.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of **TIBBS ET AL** to include the shipping label contains the machine readable code which represents a purchase

order and shipping information as taught by **SAVINO ET AL** for the advantage of more efficient and time effective than conventional systems which employ a plurality of codes which must all be individually scanned for a single part or purchase order. {see SAVINO ET AL, col. 4, lines 44-67; col. 5, lines 1-21}.

As for dep. claim 29, TIBBS ET AL inherently discloses a business rules is used to access customer data representing at least one detail about a customer associated with the transaction, {see figures 4A-6, pars. 0028-0032}

As for claim 30, TIBBS ET AL inherently discloses a business rules is used to access package data representing at least one detail about the package in which item is expected to be shipped {see figures 4A-6, pars. 0028-0032}.

AS for dep. claims 31-32, TIBBS ET AL discloses the shipping information include the choice of carrier and package information, {see figures 4A-6, pars. 0028-0032}.

Response to Arguments

7. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689

